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Docket No.: SON-1905
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Takaharu Kitada

Application No.: 09/665,667

Confirmation No.: 5559

Filed: September 20, 2000

Art Unit: 2876

For: INFORMATION PROCESSING SYSTEM,
HAND HELD CELLULAR PHONE, AND
INFORMATION PROCESSING METHOD

Examiner: K. D. Nguyen

APPELLANT'S REPLY BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief under 37 C.F.R. §41.41 is in furtherance of the Notice of Appeal, filed on April 11, 2003, supplemental to the Appeal Brief filed on June 11, 2003, and in response to the Examiner's Answer mailed on November 2, 2004.

All arguments presented in the Appeal Brief filed on June 11, 2003, are hereby incorporated by reference. Additional arguments are set forth below.

SUMMARY OF INVENTION

An information processing system 10 comprising: an information providing medium 1 that stores information in an electromagnetic or optical manner, the information providing medium 1 being attached to an entity 2 in order to provide information associated with the entity 2; a hand held terminal device 30 having an information read function 3 for reading said information from said information providing medium 1 in an electromagnetic or optical manner and recording the information therein 4; and an information processing unit 5 for retrieving said information recorded in said hand held terminal device 4, 30 and processing the information

therein; wherein said information providing medium 1 is inconspicuously attached to the entity 2. See for example, the specification at page 3, line 22 to page 4, line 9 and page 12, line 19 to page 13, line 15.

For example, a hand held cellular phone 401 (see Fig. 25A) for reading information from an information providing medium 1 inconspicuously attached to an entity 2, the hand held cellular phone 401 comprises: a telephone function; information read means 51 for reading information associated with said entity 2 from said inconspicuously attached information providing medium 1; and non-volatile storage means 42 for storing information read from said information read means. See also Figs. 1 and 3, and the specification at, for example, page 92, line 9 to page 10, line 2.

In this manner, for example, a tag 1 storing information about a product 2 can be attached to the product, and a user can retrieve the stored information for use later. See, for example, page 4, line 22 to page 5, line 8. In the case of an advertisement referring to a web site, for example, a user can store the web address for later use. See, for example, page 5, line 8. The tag for storing the information is inconspicuously attached to the entity or product. See For example, page 12, line 19 to page 13, line 15.

ISSUES

The issue presented for consideration in this appeal is as follows:

- (1) Whether the Examiner erred in rejecting Claims 1-2, 6, 10, 15-16 and 18-19 under 35 U.S.C. §103(a) as unpatentable over *Zembitski*, U.S. Patent No. 6,193,160 in view of *Reymond*, U.S. Patent No. 5,898,370?
- (2) Whether the Examiner erred in rejecting Claims 3 and 17 under 35 U.S.C. §103(a) as unpatentable over *Zembitski*, U.S. Patent No. 6,193,160 in view of *Reymond*, U.S. Patent No. 5,898,370, and further in view of *Storch et al.*, U.S. Patent 5,367,148?
- (3) Whether the Examiner erred in rejecting Claim 4 under 35 U.S.C. §103(a) as unpatentable over *Zembitski*, U.S. Patent No. 6,193,160 in view of *Reymond*, U.S. Patent No. 5,898,370, and further in view of *Gallagher III et al.*, U.S. Patent 5,959,531 and *Watada*, U.S. Patent No. 6,012,641?
- (4) Whether the Examiner erred in rejecting Claims 5, 7 and 11-14 under 35 U.S.C.

§103(a) as unpatentable over *Zembitski*, U.S. Patent No. 6,193,160 in view of *Reymond*, U.S. Patent No. 5,898,370 and further in view of *Walsh et al.*, U.S. Patent No. 6,089,456?

- (5) Whether the Examiner erred in rejecting Claims 8-9 under 35 U.S.C. §103(a) as unpatentable over *Walsh et al.*, U.S. Patent No. 6,089,456 in view of *Reymond*, U.S. Patent No. 5,898,370?
- (6) Whether the Examiner erred in rejecting Claim 20 under 35 U.S.C. §103(a) as unpatentable over *Zembitski*, U.S. Patent No. 6,193,160 in view of *Reymond*, U.S. Patent No. 5,898,370, and further in view of *Storch et al.*, U.S. Patent 5,367,148?

ARGUMENTS

Claims 1-2, 6, 10, 15-16 and 18-19 are rejected under 35 U.S.C. §103(a) over *Zembitski*, U.S. Patent No. 6,193,160 in view of *Reymond*, U.S. Patent No. 5,898,370. Appellant respectfully traverses this rejection.

The Examiner's Answer alleges that it would have been obvious for one of ordinary skill in the art to combine the inconspicuously attached radio frequency tag as taught in *Reymond* with the teachings of *Zembitski* in order to prevent an unauthorized manipulation and/or tempering of the tag by the vendee and/or to maintain the original aesthetic look of the entity without the attachment of the information providing medium/tag on the entity. However, the Examiner's Answer failed to address Appellant's argument whether device of *Zembitski* would maintain operability when combined with the teachings of *Reymond*. In particular, Appellant argued that because *Zembitski* teaches the label must be conspicuously or knowingly in the line of sight of the scanner, hiding the label as taught in *Reymond* would render *Zembitski* inoperative. Moreover, the Examiner's Answer still has failed to remedy the deficiencies of the final rejection by failing to establish that one of ordinary skill would hide the label in *Zembitski*. Because the Examiner's Answer has failed to address at least the foregoing arguments, Appellant submits that any counter-arguments have been acquiesced and the Appellant's position has been accepted as true. For at least these reasons, a *prima facie* case for obviousness has not been established, and Appellant respectfully requests that the rejection to claims 1-2, 6, 10, 15-16, and 18-19 not be sustained.

Claims 3 and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Zembitski* in view of *Reymond*, and further in view of *Storch et al.*, U.S. Patent 5,367,148. Appellant respectfully traverses this rejection.

The Examiner's Answer alleges that it would have been obvious for one of ordinary skill in the art to combine the capability to discriminate between genuine and counterfeit bar-coded information-providing-medium as taught by *Storch* with the teachings of *Zembitski* and *Reymond* in order to prevent duplication or modification of the original product. However, the Examiner's Answer failed to address Appellant's argument whether device of *Zembitski* would maintain operability when combined with the teachings of *Reymond* and *Storch*. In particular, Appellant argued that in order for the combined scheme to work in light of the teachings of *Zembitski* and *Reymond*, the outer tag of *Storch* must be conspicuous. Thus, at least one tag of *Storch* must be conspicuous and in plain view and cannot be inconspicuously attached to the entity as recited in the independent claim. Because the Examiner's Answer has failed to address at least the foregoing arguments, Appellant submits that any counter-arguments have been acquiesced and the Appellant's position has been accepted as true. For at least these reasons, a *prima facie* case for obviousness has not been established; and Appellant respectfully requests that the rejection to claims 3 and 17 not be sustained.

Claims 8-9 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Walsh et al.*, U.S. Patent No. 6,089,456 in view of *Reymond*. Appellant respectfully traverses this rejection.

The Examiner's Answer alleges that it would have been obvious for one of ordinary skill in the art to combine the inconspicuously attached radio frequency tag as taught in *Reymond* with the teachings of *Walsh* in order to prevent an unauthorized manipulation and/or tempering of the tag by the vendee and/or to maintain the original aesthetic look of the entity without the attachment of the information providing medium/tag on the entity. However, the Examiner's Answer failed to address Appellant's argument whether device of *Walsh* would maintain operability when combined with the teachings of *Reymond*. In particular, Appellant argued that because *Walsh* teaches that the label must be conspicuously or knowingly in the line of sight of the scanner, hiding the label as taught in *Reymond* would render *Walsh* inoperative. Moreover, the Examiner's Answer still has failed to remedy the deficiencies of the final rejection by failing to establish that one of ordinary skill would hide the label in *Walsh*. Because the Examiner's

Answer has failed to address at least the foregoing arguments, Appellant submits that any counter-arguments have been acquiesced and the Appellant's position has been accepted as true. For at least these reasons, a *prima facie* case for obviousness has not been established, and Appellant respectfully requests that the rejection to claims 8 and 9 not be sustained.

Claim 20 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Zembitski* in view of *Reymond*, and further in view of *Storch et al.* Appellant respectfully traverses this rejection.

The Examiner's Answer alleges that it would have been obvious for one of ordinary skill in the art to combine the capability to discriminate between genuine and counterfeit bar-coded information-providing-medium as taught by *Storch* with the teachings of *Zembitski* and *Reymond* in order to prevent duplication or modification of the original product. However, the Examiner's Answer failed to address Appellant's argument whether device of *Zembitski* would maintain operability when combined with the teachings of *Reymond* and *Storch*. In particular, Appellant argued that in order for the combined scheme to work in light of the teachings of *Zembitski* and *Reymond*, the outer tag of *Storch* must be conspicuous. Thus, at least one tag of *Storch* must be conspicuous and in plain view and cannot be inconspicuously attached to the entity as recited in claim 20. Because the Examiner's Answer has failed to address at least the foregoing arguments, Appellant submits that any counter-arguments have been acquiesced and the Appellant's position has been accepted as true. For at least these reasons, a *prima facie* case for obviousness has not been established, and Appellant respectfully requests that the rejection to claim 20 not be sustained.

CONCLUSION

In view of the above discussion, Appellant respectfully submits that the final rejection of claims 1-20 is improper and should not be sustained. Accordingly, Appellant respectfully requests that the final rejection of claims 1-20 expressed in the Office Action of December 12, 2002 (Paper No. 9) be reversed.

Applicant believes no fee is due with this request. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. SON-1905 from which the undersigned is authorized to draw.

Dated:

12/17/04

Respectfully submitted,

By

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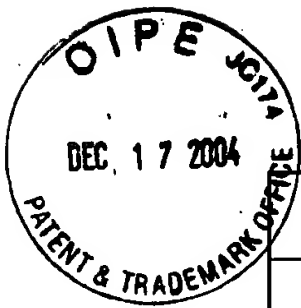
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AMENDMENT TRANSMITTAL LETTER

Docket No.
SON-1905

Application No.
09/665,667-Conf. #5559

Filing Date
September 20, 2000

Examiner
K. D. Nguyen

Art Unit
2876

Applicant(s): Takaharu Kitada

Invention: INFORMATION PROCESSING SYSTEM, HAND HELD CELLULAR PHONE, AND
INFORMATION PROCESSING METHOD

TO THE COMMISSIONER FOR PATENTS

Transmitted herewith is an amendment in the above-identified application.

The fee has been calculated and is transmitted as shown below.

CLAIMS AS AMENDED					
	Claims Remaining After Amendment	Highest Number Previously Paid	Number Extra Claims Present	Rate	
Total Claims	20	- 20 =		x 0.00	0.00
Independent Claims	4	- 4 =	1	x 0.00	0.00
Multiple Dependent Claims (check if applicable) <input type="checkbox"/>					
Other fee (please specify):					
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT:					0.00

☒ Large Entity

☐ Small Entity

☒ No additional fee is required for this amendment.

☒ Please charge Deposit Account No. 18-0013 in the amount of \$ 0.00.
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☐ Payment by credit card. Form PTO-2038 is attached.

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Dated: December 17, 2004

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